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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,170	10/28/2003	Tsutomu Ikeda	1232-5186	7633
27123	7590	11/18/2004	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			SPECTOR, DAVID N	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/696,170

Applicant(s)

IKEDA, TSUTOMU

Examiner

David N. Spector

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/28/03; 04/07/04; and 04/30/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) 2 is/are objected to.
- 8) ☒ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040430.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: DETAILED ACTION.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 9 is rendered indefinite by the use of the "pan shape" (Claim 9, Line 2). Claim 10 is rendered indefinite by the use of the term "pan space" (Claim 10, Line 1). Correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, and 3-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 2002-139749 (Seiko Epson Inc.). *EXAMINERS NOTE: JP 2002-139749 was cited by applicant in an Information Disclosure Statement filed 04/30/2004.*

In regard to Claim 1 An electrophoretic display 1 is disclosed in JP 2002-139749 ([0011]-[0012]; FIG. 1-3) which includes first substrate 3 (e.g. referred to as "second substrate" in JP 2002-139749) disposed on a viewer side (e.g. defined as "screen side" in JP 2002-139749) a second substrate 2 (e.g. referred to as "first substrate" in JP 2002-139749) disposed at a predetermined spacing with said first substrate 3, a first electrode 5 (e.g. referred to as "second electrode" in JP 2002-139749) disposed on said first substrate 3 side, a second electrode 4 (e.g. referred to as "first electrode" in JP 2002-139749) disposed on said second substrate 2 side, liquid 17 disposed at the predetermined spacing, and a plurality of charged particles 16 dispersed in the liquid 17, said charged particles being movable by changing a polarity of a voltage applied be-

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tween said first 5 and second electrodes 4 to effect display, wherein said second electrode 4 at a pixel has a surface area larger than that of said first electrode 5 at the pixel, which can clearly be seen in FIG. 1-3). Claim 1 of the instant application is therefore clearly anticipated by the disclosure of JP 2002-139749.

In regard to Claim 3 An electrophoretic display according to claim 1 from which claim 3 depends is disclosed in JP 2002-139749 ([0011]-[0012]; FIG. 1-3) wherein said first electrode 5 is also divided for a pixel ([0013]; FIG. 3A). Claim 3 is therefore clearly anticipated by the disclosure of JP 2002-139749.

In regard to Claim 4 An electrophoretic display according to claim 3 from which claim 4 depends is disclosed in JP 2002-139749 ([0011]-[0012]; FIG. 1-3) wherein said first electrode 5 is also connected to an associated switching device for the pixel. ([0028]). Claim 4 is therefore clearly anticipated by the disclosure of JP 2002-139749.

In regard to Claim 5 An electrophoretic display according to claim 1 from which claim 5 depends is disclosed in JP 2002-139749 ([0011]-[0012]; FIG. 1-3) wherein said second electrode 4 is also divided for a pixel ([0013]; FIG. 3A). Claim 5 is therefore clearly anticipated by the disclosure of JP 2002-139749.

In regard to Claim 6 An electrophoretic display according to claim 5 from which claim 6 depends is disclosed in JP 2002-139749 ([0011]-[0012]; FIG. 1-3) wherein said second electrode 4 is also connected to an associated switching device for the pixel. ([0028], [0039]). Claim 6 is therefore clearly anticipated by the disclosure of JP 2002-139749.

In regard to Claim 7 An electrophoretic display according to claim 1 from which claim 5 depends is disclosed in JP 2002-139749 ([0011]-[0012]; FIG. 1-3) wherein said charged particles 16 and said liquid 17 are also held in a microcapsule 7. Claim 7 is therefore clearly anticipated by the disclosure of JP 2002-139749.

In regard to Claim 8 An electrophoretic display according to claim 1 from which claim 5 depends is disclosed in JP 2002-139749 ([0011]-[0012]; FIG. 1-3) wherein an insulating layer is disposed at the surfaces of said first 5 and second 4 electrodes ([0023]). Claim 8 is therefore clearly anticipated by the disclosure of JP 2002-139749.

***Allowable Subject Matter***

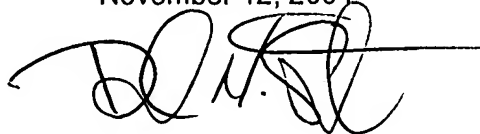
5. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: claim 2 is distinguished over the prior art made of record by the inclusion of an inner wall which is substantially covered with said first 5 and second 4 electrodes within each pixel of display.

***Other Remarks/Information***

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7. Any other inquiry concerning this communication or earlier communications from the examiner should be directed to David N. Spector whose telephone number is (571) 272-2338. The examiner can normally be reached at this number Monday through Friday between 6:00 AM and 2:30 PM. The fax number for the organization where this application is assigned is (703) 872-9306.

November 12, 2004

A handwritten signature in black ink, appearing to read 'D. N. Spector', with a long horizontal line extending to the right.

DAVID N. SPECTOR  
PRIMARY EXAMINER